

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested. New claims 67-69 has been added. With this amendment, claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, 29-31, 34-44, 47-49, 52-54, 57-59 and 62-69 are pending in this case. All amendments find support in the application as originally filed. Applicants reserve the right to prosecute any cancelled or otherwise unclaimed subject matter of this patent application in continuation or divisional application. Based on the amendment and remarks presented herein, applicants submit that the application is now in condition for allowance.

### **Rejections Under 35 U.S.C. 112, First Paragraph**

Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, 29, 30, 40-44, 47-49, 52-54, 57-59 and 62-66 stand rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement. Applicants respectfully traverse these rejections as indicated below.

The Examiner alleged that the claims were not enabled because “[t]he specification described a T cell response only in the context of BFA4 peptides.” While BFA4 peptides were used to identify BFA4-reactive cells in the spleens of immunized mice following *in vivo* immunization using a BFA4 expression vector, those mice were immunized with the expression vectors only and not BFA4 peptides. As described at Example 1D (paragraphs [0114]-[0116]) of the instant specification, Applicants demonstrated the induction of a T cell response in mice following *in vivo* administration of either plasmid- or poxvirus-based vectors encoding BFA4. BFA4 peptides were simply used to measure the immune response *in vitro* that was induced *in vivo* by the BFA4 expression vectors; the peptides were not administered to the animals in Example 1D. To the extent these studies were previously characterized as including a peptide boost, such characterization is hereby withdrawn. Applicants maintain, therefore, that the specification enables the instantly pending claims. It is therefore respectfully requested that these rejections be withdrawn.

### **Rejections Under 35 U.S.C § 103(a)**

Claims 1, 4, 5, 21, 24-26, 29, 30, 44, 47 an 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gish (U.S. Pat. No. 6,780,586) and Ghose et al. (Human Gene Therapy, 2000, Vol. 11, pp. 1289-1301). Applicants respectfully disagree and traverse these rejections as indicated below.

To properly establish a *prima facie* case of obviousness, the Examiner is required to provide “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP 706.02(j). While an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim”, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness...[t]o facilitate review, this analysis should be made explicit.”. KSR Int’l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007) (p. 14) citing In re Kahn, 441 F.3d 977, 988. The mere fact that the prior art may be modified does not make the modification obvious unless the prior art suggests the desirability thereof. In re Lahu, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984). In this Office Action, the Examiner merely concludes that because Gish teaches SEQ ID NO.: 1 and Ghose teaches canarypox vectors, Applicants’ use of poxvirus vectors to express a nucleic acid encoding BFA4 would have been obvious. The Examiner provides no evidence of the desirability by anyone skilled in the art to obtain the claimed inventions or any “rational underpinning” for these conclusions. The Examiner has not provided any evidence of a suggestion or motivation to produce the claimed inventions, any reasonable expectation of success in doing so, or that the cited references either explicitly or implicitly teaches the claimed invention. The Examiner’s rejection is wholly inadequate to properly support an obviousness rejection. Thus, Applicants believe that the Examiner has not established a *prima facie* case of obviousness of the pending claims and therefore respectfully request its withdrawal.

### **CONCLUSIONS**

Consideration and entry of this response is respectfully requested. Applicants believe the claims are now in condition for allowance, and respectfully request that a Notice of Allowance be issued as soon as possible. The examiner is encouraged to contact the undersigned if it is believed doing so would assist in the examination of this application

Respectfully submitted,

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